

Application No. 10/758,767
Amendment Dated March 6, 2009
Reply to Office Action of December 9, 2008

REMARKS

In the Office Action dated December 9, 2008, claims 1, 3, 4, 7, 9, 12-15, 22-26, 29-32, 35-38 and 41-51 were examined with the result that all claims were rejected. The rejection is non-final. In response, Applicant has cancelled claims 3 and 42, and amended claims 1, 20, 41 and 43. In view of the above amendments and following remarks, reconsideration of this application is requested.

Before turning to the rejections of record, Applicant would like to briefly discuss the amendments made to the claims via the present response. More specifically, the Examiner has objected to the broad scope of claim 1 as covering a large number of retinoid esters. In response, Applicant has limited claim 1 to a tertiary alcohol wherein the tertiary substituents are now limited to an alkyl group having 1 to 5 carbon atoms instead of 1 to 10 carbon atoms and aryl. This is a significant reduction in the scope of the compounds being claimed in claim 1. In addition, the Examiner objected to the scope of claim 20 as covering a broad range of diseases. In response, Applicant has limited claim 20 to covering only psoriasis and skin disorders selected from the group consisting of dermatitis, eczema and keratosis. The Examiner will note that the various cancers previously listed in claim 20 have been cancelled, which once again results in a significant narrowing of claim 20. This same limitation has also been incorporated into claim 43, so that claim 43 now only covers psoriasis and the selected skin disorders. Finally, claim 41 has been amended to limit the scope of the retinoid ester claimed to one where the tertiary substituents are an alkyl group having 1 to 5 carbon atoms instead of 1 to 10 carbon atoms and an aryl group. Again, this is a significant reduction in the scope of claim 41. The Examiner will note that support for the amendments made to claims 1 and 41 can be found in the specification as filed at page 10, lines 8-11 wherein the alkyl group is specifically stated to be "preferably 1 to 5 carbon atoms". Thus, no new matter has been added to claims 1 or 41.

Applicant would now like to turn to the rejections of record. In the Office Action, the Examiner first rejects claims 1, 3, 4, 7, 9 and 12-15 on the ground of obviousness type double patenting in view of claim 18 of U.S. Patent 7,126,017. In response, Applicant filed a Terminal Disclaimer with its response dated March 31, 2008 in order to overcome this double patenting

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rejection. Previously, the Examiner indicated that the double patenting rejection would be withdrawn when the Terminal Disclaimer has been approved by the USPTO. Applicant believes the previous Terminal Disclaimer as filed should be approved, but upon checking on PAIR, Applicant notes that the Terminal Disclaimer filed March 31, 2008 has been disapproved because "Attorney not of record". However, the undersigned is, in fact, the attorney of record, and PAIR clearly evidences that the undersigned is the attorney of record. Applicant encloses a copy of the disapproval of the Terminal Disclaimer, as well as a copy of the information page evidencing the undersigned as the attorney of record. Applicant also encloses a copy of the original inventor Declaration as filed which also evidences the undersigned is the attorney of record. Thus, Applicant believes that the USPTO is incorrect, and that the undersigned is in fact the attorney of record. Accordingly, the previously-filed Terminal Disclaimer should be approved, and Applicant requests such approval from the Examiner. The previously-filed Terminal Disclaimer should overcome the obviousness type double patenting rejection of these claims, and Applicant herein requests the Examiner to withdraw that rejection.

In the Office Action, claims 1, 3, 4, 7, 12, 13, 20-22, 26, 29-32, 35-38 and 43-51 were rejected under 35 U.S.C. §112, first paragraph, because the Examiner believes the specification does not reasonably provide enablement for all the treatments of diseases as claimed in original claims 20 and 43 and all the compounds as claimed in claim 1. The Examiner states that the specification does not teach one skilled in the art how to make and use "the full scope" of the claimed invention without undue experimentation.

In response, Applicant notes that claim 1 has been limited to a retinoid ester having a highly sterically hindered tertiary functional group wherein the tertiary substituents are limited to an alkyl group having 1 to 5 carbon atoms. Previously, claim 1 covered 1 to 10 carbon atoms and an aryl group. Thus, Applicant has significantly limited claim 1. Applicant further believes that the data pertaining to the t-butyl retinoid ester may be reasonably expanded to cover tertiary alkyl substituents having 1 to 5 carbon atoms. In addition, claim 1 had been previously limited to a select group of retinoids by using a Markush grouping. Therefore, Applicant believes claim 1 is enabled by the specification as filed. Also, the Examiner will

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note that claim 41 has been limited to a retinoid ester comprising an all trans retinoic acid tertiary ester wherein the tertiary substituents may be an alkyl group of 1 to 5 carbon atoms. Again, Applicant believes the specification provides enablement for 1 to 5 carbon atoms, even though the exemplified embodiment has only 1 carbon atom, i.e. a methyl group in each of the three tertiary positions.

With regard to the Examiner's objection to the broad scope of diseases claimed in claims 20 and 43, the Examiner will note that Applicant has eliminated all of the cancers from the scope of those two claims. Thus, claims 20 and 43 are only directed toward the treatment of psoriasis or a skin disorder selected from dermatitis, eczema and keratosis. Applicant believes the instant claims comply with the enablement requirement since a person of ordinary skill in the art would not have to engage in undue experimentation to practice the claimed invention. Retinoids have been known in the art to be used for diseases such as psoriasis, dermatitis, eczema and keratosis so one skilled in the art would readily recognize and correlate that the instantly claimed compounds could be useful for such purposes. Accordingly, Applicant requests the Examiner withdraw the §112, first paragraph rejection of the claims.

An effort has been made to place this application in condition for allowance and such action is earnestly requested.

Respectfully submitted,

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